

REMARKS

Claims 1-17 and 28 are now in the case.

Claims 18-27 have been canceled.

No Claim has been allowed.

Original Claims 6, 7, 10 and 11 had been objected to in the previous Office Action dated April 19, 2005, and indicated to be allowable if rewritten in independent form. The claims were so rewritten in the response filed on May 16, 2005, and are now subject to further rejection as discussed below.

The Rejection under 35 U.S.C. §103(a).

Claims 1-17 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fanta et al. (*J. of Applied Polymer Science*) in view of Weaver et al. The Examiner has taken the position that the earliest effective filing date for the current application is November 20, 2002, since the parent U.S. application does not support the graft copolymer limitations. Withdrawal of the rejection is in order for the following reasons.

The Examiner has clearly acknowledged that the Fanta et al. publication fails to teach graft copolymers of solubilized starch. Applicants agree with the Examiner in that regard. The Fanta et al. publication teaches the non-

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grafted solubilized starch coating invention of the parent application, now U.S. Patent No. 6,709,793, to which the present application claims priority. The priority date of the parent case is November 20, 2001, and predates the effective date of the reference by over six months. Thus, to the extent that the publication teaches the claimed invention, Applicants' have disclosed that invention in an earlier priority document. Given that the invention described in the publication is attributed to the inventors of U.S. Patent No. 6,709,793, who are the same as the Applicants of the present application, there is no statutory basis for a rejection based on the teachings of that reference. To hold otherwise would undermine all intended benefits of a priority document under 35 U.S.C. §120. Although the Examiner is correct in stating that the earliest effective filing date for the current application (related to grafted starch copolymer coatings) is November 20, 2002 (the date of the PCT filing), that does not preclude Applicants' benefit of priority regarding the use of solubilized starch as a non-grafted coating (the subject of the applied publication).

Even assuming *arguendo* that Applicants' earliest effective date were November 20, 2002, the Fanta et al. publication would be a non-barring disclosure given that

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it's effective date is less than 1 year prior to November 20, 2002. Submitted herewith is a Katz Declaration under 37 CFR 1.132 establishing that coauthors Shogren and Salch did not contribute to the inventive concept of either the non-grafted coating embodiment of the parent U.S. application or of the grafted coating embodiment of the present case, and that their respective contributory roles to the publication were other than inventorship. Accordingly, the publication is effectively a disclosure by the Applicants themselves, and serves to establish that the Applicants had possession of the invention as of the effective date of the publication.

Without availability of the teachings of Fanta et al., Weaver et al. serves no purpose in regard to rendering obvious the claimed invention. Weaver fails to show an article of manufacture comprising a hydrophobic polymeric substrate having an adherent, firmly attached hydrophilic coating of a graft copolymer of solubilized starch.

For the aforementioned reasons, the rejection is deemed to be without basis and should be withdrawn.

Double Patenting.

Claims 1-17 and 28 are rejected under the judicially-created doctrine of obviousness-type double patenting as

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being unpatentable over Claims 1-23 of U.S. Patent No. 6,709,763 in view of Weaver et al. This rejection is deemed to be without merit and its withdrawal is requested for the following reasons.

As noted above, the present case claims priority under 35 U.S.C. §120 to November 20, 2001, the filing date of U.S. Patent No. 6,709,793. Accordingly, the term of the application will be commensurate with the term of the patent.

Applicants also contend that the invention of Claims 1-17 and 28 is not an obvious variation of the claims of the U.S. Patent No. 6,709,793 for the reason that there is no suggestion in either this patent or in Weaver et al. that the grafted solubilized coating would have the unexpected properties of curling memory and superior adherence (See Example 17, paragraphs [0049] and [0050]). Similar results are described in Examples 20 and 21. In contrast, the non-grafted film of Example 22 was not adherent to polyethylene film when subjected to boiling water. Notwithstanding, in an effort to advance the prosecution of the case, submitted herewith is a Terminal Disclaimer in compliance with 37 CFR 1.321(c) serving to disclaim the terminal part of the statutory term of a patent granted on the instant application which would

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extend beyond the expiration date of the statutory term of U.S. Patent No. 6,709,763.

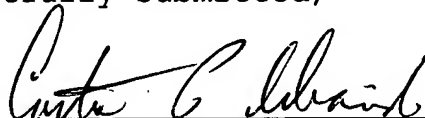
Summary.

Applicants have demonstrated that the primary reference in the rejection under 35 U.S.C. §103(a) is a non-barring disclosure by the Applicants of the invention described in the parent patent to which priority is claimed. The non-applicant co-authors of the publication have submitted declarations establishing that they are not inventors of either the invention claimed in the parent case or of the invention set forth in the claims of the present application. Regarding the double patenting rejection, Applicants have taken the position that Claims 1-17 and 28 are patentably distinct from the claims of the parent Patent No. 6,709,763 and would not be obvious in view of Weaver. Nonetheless, Applicants have submitted a terminal disclaimer to obviate that rejection.

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All the claims in the case are now deemed to be free of the applied rejections and in condition for allowance. If the Examiner wishes to discuss any remaining issues in the case, she is invited to call the undersigned at (309) 681-6512.

Respectfully submitted,



Curtis P. Ribando, Agent of Record
Registration No. 27,976

Peoria, IL

COM 309/681-6512
FAX 309/681-6688

Enclosures
FY 2005 Fee Transmittal (2 orig.)
Shogren Declaration
Salch Declaration
Terminal Disclaimer